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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/427,892 | 10/26/1999 | RAIMUND WEIFFEN | 4452-263 | 3906 |

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EXAMINER

WILLIAMS, THOMAS J

ART UNIT

PAPER NUMBER

3683

DATE MAILED: 01/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/427,892

Applicant(s)

WEIFFEN ET AL.

Examiner

Thomas J. Williams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 12 April 2001 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 15, 2002 has been entered.
2. Acknowledgment is made in the receipt of amendment E filed October 15, 2002.

Claim Objections

3. Claims 1-7 and 9-10 are objected to because of the following informalities: for consistency "said damping fluid" in claim 1 lines 14 and 15 should be replaced with "damping medium". Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-^{9, 10} rejected under 35 U.S.C. 102(b) as being anticipated by US 5,244,063 to Laurien et al.

Re-claim 1, Laurien et al. discloses a vibration damper with a variable damping force, comprising: a working cylinder 1 filled with a damping medium; a piston 2 fastened to a piston rod 3, the piston divides the working cylinder into two working chambers 1' and 1''; first and second non-return valves, such as 17 and 18, are arranged in the piston for providing a damping

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force for the rebound and compression directions of the vibration damper; a damping valve P5 is arranged in the piston and comprises a valve body 23 and a valve seat 24 that define a flow path therebetween, the damping valve has a selectively adjustable variable damping action, see column 5 lines 11-16, and is arranged in series with each of the first and second non-return valves, the damping valve acts in both the rebound and compression directions and will offset the damping force provided by each of the first and second non-return valves, the damping valve in series with the first and second non-return valves comprise a sole passage for the damping medium through the piston between the two working spaces such that the damping fluid (or medium) is required to flow through the flow path of the damping valve when damping fluid is exchanged between the two working spaces in the rebound and compression directions.

During rebound fluid flows through non-return valve 17, into chamber 14, through the flow path defined by valve body 23 and seat 24, into passage 33 and finally through non-return valve 35. During compression fluid flows through non-return valve 18, into chamber 14, through the flow path defined by valve body 23 and seat 24, into passage 32 and finally through non-return valve 34. The damper of Laurien et al. has no other connection between the two working chambers.

Re-claim 2, the damping valve comprises and externally activated actuator 28 for adjusting the variable damping action, see column 7 lines 18-24.

Re-claim 3, the non-return valves are disclosed as being elastic plates and are thus considered spring loaded valve disks.

Re-claim 4, the damping valve is precontrollable to a precontrolled setting, such as when the magnet lacks current.

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Re-claim 5, the damping valve comprises and electromagnet 26 and 27.

Re-claim 6, the first 17 and second 18 non-return valves are accommodated together with their valves seats. The non-return valves are accommodated in chamber 14 or part of plate 13.

Re-claim 7, the non-return valve are formed as part of assembly 12 and 13, and are thus considered pre-assembled prior to insertion into casing 10.

Re-claim 9, the first non-return valve 17 communicates with the upper working space 1' and the second non-return valve 18 communicates with the lower 1'' working space, the damping valve 23 actuates via at least one flow connection 21 to the lower working space.

Re-claim 10, the valve body is in a precontrolled setting in one of the rebound and compression directions and is controllable via an actuator 28 in the other of the rebound and compression directions. The precontrolled setting occurs when the electromagnet is not charged.

Response to Arguments

6. Applicant's arguments with respect to claims 1-7 and 9-10 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bernhardt et al. teaches a damper having a sole passage through a piston.

8. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Thomas Williams whose telephone number is (703) 305-1346. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 4:00 PM. The examiner can also be reached on alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Lavinder, can be reached at (703) 308-3421. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

TJW

January 7, 2003

Thomas Williams
AU 3683
1-07-03
THOMAS WILLIAMS
PATENT EXAMINER